The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

<u>Ex parte</u> MICHAEL F. QUINN,
JAMES MCGINLAY and
ROMAN KADRON

Appeal No. 2000-1442
Application 08/626,600

ON BRIEF

Before URYNOWICZ, KRASS, and LEVY, <u>Administrative Patent Judges</u>.

URYNOWICZ, <u>Administrative Patent Judge</u>.

Decision on Appeal

This appeal is from the final rejection of claims 1-12 and 14-32. The rejection of claim 28 under 35 U.S.C. § 112 has been withdrawn.

The invention pertains to organizing and retrieving documents and material associated with the documents. Claim 14 is illustrative and reads as follows:

14.   A process of trade records information management
system for storing, searching, and retrieving data
pertaining to financial transactions comprising the
steps of:

preprocessing inbound paper-based documents
including scanning the inbound paper-based documents;

indexing the inbound paper-based documents;

storing bit mapped images;

storing ASCII information about the bit mapped images;

storing messages and completed inquiries;

inputting data into a central data storage means
from a plurality of sources;

indexing input data in the central data storage
means and creating a transaction data folder, each
transaction data folder containing a unique identifier
and a bit mapped image file containing the image of at
least one hard copy document, ASCII information about
the at least one hard copy document, messages and
completed inquiries.

The references relied upon by the examiner are:

Cukor et al. (Cukor)   5,168,444   Dec. 01, 1992

Wang et al. (Wang)   5,490,217   Feb. 06, 1996
                                                  (filed Mar. 05, 1993)

Dysart, J., "A Shortcut in the Paper Chase", Distribution,
vol.93, no.1, January 1994, p. 42, 43.

Reding, T., "Digital Imaging Technology: What, Where and Why in
Commercial Nuclear Power", Nuclear Plant Journal, vol. 9, no. 4,
July-August 1991, p. 89, 90 and 94.

Claims 1-12, 14-25, 27-29 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cukor and Reding.

Claims 26 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cukor and Reding further in view of Wang.

Claim 31 stands rejected under 35 U.S.C. § 103 as being unpatentable over Cukor and Reding further in view of Dysart.

The respective positions of the examiner and the appellants with regard to the propriety of these rejections are set forth in the final rejection and the examiner's answer (Paper Nos. 12 and 18, respectively) and the appellants' brief and reply brief (Paper Nos. 16 and 21, respectively).

Appellants' Invention

The invention is described at pages 2 and 3 of the brief.

The Prior Art

With respect to Figure 1, Cukor discloses an integrated digital system for image processing of documents generated in shipping transactions which includes one or more central transaction processing facilities 11 that receive images of shipping transaction documents. (See column 6, lines 1-10, for plural central transaction processing facilities). The document images may be captured by scanners at a plurality of remote

stations 10 associated with each central facility or they may be telefaxed (FAX STATION) directly to a processing facility by individual shippers. A central shipping transaction database is maintained on a host computer 19 along with appropriate applications for processing the transaction data and invoicing the transactions. The system includes a plurality of image processing stations 18 at each central facility, at which key operators may view the images of shipping documents according to predetermined workflow queues and, based on the images of the documents, enter transaction data into the shipping transaction database. The system allows for printing of transaction invoices from the data in the database along with a hard copy of any shipping document images which are to accompany the invoices.

Reding discloses that digital imaging technology systems may incorporate local and wide area network communications (page 89, column 1, second paragraph), that document scanners create bit-maps of the documents (page 89, column 2, last paragraph) and that information is converted to ASCII characters (page 89, column 2, last paragraph).

Wang teaches digital imaging technology systems wherein computer business, medical and other office files may be updated (column 1, lines 18-28; column 5, lines 44-52) and that different systems can exchange information through different business transaction forms (column 6, lines 27-51).

Dysart teaches the graphical imaging of financial documents across a network in which the scanned images are transferred electronically to regional processing centers at night (page 2, lines 3-7).

Grouping of Claims

At page 4 of the brief, appellants state that the claims do not stand or fall together.

Opinion

Appellants' first argument, which appears in the last paragraph of page 5 of the brief, is that Cukor's Figure 1 does not illustrate a plurality of regional centers being networked together. This argument is unpersuasive because the examiner refers to the reference's description of Figure 1 at columns 5 and 6, and it is this description which is relied on for a teaching of regional centers being networked together.

At the top of page 6 of the brief, it is argued that column 5, line 31 - column 6, line 10, fails to mention a plurality of regional centers.

Appellants' regional center of Figure 1 comprises optical store 118 and magnetic store 120. In Figure 1, Cukor's regional center comprises optical store 16 and magnetic store 15. Because Cukor teaches several central processing stations 11 at column 6, lines 3-6, and each of his stations would contain stores 15 and 16, Cukor teaches a plurality of regional centers.

At page 6, appellants argue that Cukor does not teach networking. This is unpersuasive because, with respect to Figure 1, the reference teaches remote scanning stations 10 (e.g., freight terminals) connected to processing facility 12. A wide area network (WAN) of necessity provides the communication between the remote stations (freight terminals) 10 and processing facility 12. The WAN would also provide the communication between the several processing stations and the computer 19 serving the processing stations.

Further at page 6, it is submitted that Cukor does not allow a customer at a first processing facility 12 to obtain information from a second processing facility. This argument is

not persuasive because a separate computer 19, which can serve

several central processing stations 11, facilitates communication

among facilities 12. At column 5, lines 47-55, Cukor discloses

that the invention may include several "central" transaction

processing stations 11 distributed over a large geographic area.

In such an embodiment, the network interconnecting the stations

is referred to in the art as a wide area network (WAN). The

central stations being interconnected, any customer at a remote

station 10 associated with a particular central station 11 is

able to access information at any other central location. To

assume, as does appellants, that in the above embodiment Cukor's

central stations 11 are electronically "separated" or isolated

simply make no sense because one would have to assume that Cukor

is disclosing a plurality of like but separate, unconnected

systems over a large geographic area. There would be no reason

for Cukor to refer to separate, isolated systems, as in distant

cities. A clear indication in the reference that the central

networks are not isolated systems is that a separate computer may

serve the several central processing stations (column 6, lines

1-6).

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Still further in this regard, the disclosure of Reding at column 1 of page 89 is that digital imaging technology encompasses wide area network communications. This certainly enforces the position that the central stations 11 of Cukor are not separate systems.

At pages 7-9 of the brief, appellants argue to the effect that they are unable to find mention in Cukor of any reference relating to messages and completed inquiries. This position apparently relates to the second paragraph of claim 1 which calls for customer service units having local data storage means for storing folders which contain bit mapped images, messages and completed inquiries.

This position is unpersuasive because at column 10, lines 41-54, Cukor teaches remote stations where scanned documents (bit mapped images) are stored in a local image file (folders) in a local magnetic storage device (local data storage means), and because at column 21, line 12 - column 22, line 11, Cukor teaches various types of messages, including acknowledgments and commands, issued to a remote station from the central station. An acknowledgment signal from the central station in response to a status request from a remote station is a completed inquiry.

At page 10, item 2c., appellants argue that the examiner has not set forth motivation for Cukor to process or handle messages and inquiries. This is not persuasive in view of our discussion, above, acknowledging that Cukor teaches messages and inquiries.

At page 11 of the brief, and specifically with respect to claim 4, appellants state to the effect that the examiner has taken Official Notice that monitoring the work of another, backlog processing and assigning access privileges are well known processes within the prior art, and requests that the examiner provide a reference showing these features. MPEP § 2144.03.

We agree with the examiner that, under the circumstances of this case, he need not provide a reference. After the examiner took Official Notice of the above subject matter, that notice was not traversed by appellants in their subsequent response of February 27, 1998. The examiner issued a final rejection on May 27, 1998 and prosecution on the merits of this case was closed as of that date.

At page 11, appellants further argue that there is no motivation to combine the features which the examiner took Official Notice of with the teaching of Cukor. It is argued

there is no reason for the key operator in Cukor to monitor the work of another key operator.

Appellants' argument is not persuasive. Cukor discloses operator-run processing workstations 18 for performing various functions, e.g., indexing, commodity entry and exception (column 11, lines 16-22). A reason for monitoring would have been to check the accuracy of the work product of an inexperienced operator.

At item 2e. of the brief, pages 12 and 13, it is asserted that Cukor "deals with an actual space on a magnetic disk whereas the present invention relates to a transaction folder" and that these are two separate entities, and that Cukor does not teach a "financial folder".

Cukor's folders are financial folders in that they include documents, including invoices, generated in shipping transactions. Additionally, we are not persuaded by appellants' argument that Cukor does not teach transaction folders for the reasons set forth by the examiner at page 9, item 15., of the answer.

It is argued to the effect at item 2f., page 13, that Cukor does not meet the limitation "means for assigning a transaction

data folder to a particular user based upon a predetermined routing procedure" of dependent claim 6. Appellants state that they are "… unable to find any reference of a routing procedure…" in either location of Cukor's specification (column 6, lines 49-60 and column 10, lines 22-40) relied on by the examiner.

The examiner's response is at item 16. in the answer. The position taken is to the effect that Cukor discloses a manual procedure for assigning a file to a user, and that it would have been obvious to utilize an automated assignment procedure. In re Venner, 262 F.2d 91, 120 USPQ 192, 194 (CCPA 1958).

We are not persuaded by appellants' position. In response to appellants' argument, the examiner responded with a reasonable position based on Venner and there is no rebuttal thereof in the reply brief.

At item 2g., pages 13 and 14 of the brief, it is argued that Cukor fails to teach or suggest retrieving images from local storage. Based on citations relied on by the examiner, appellants contend that Cukor is only providing enough memory to support daily transactions and not long term storage. Appellants presume that the stored documents are "overwritten" by the

documents of the next day and that this is not storage. It is
alleged that Cukor's system does not check to determine if the
requested document is stored locally before requesting the data
from the central site.

This argument is unpersuasive. There is simply no doubt
that Cukor stores files locally, that is, at stations 10. See,
for example, column 10, lines 46-54). As noted by the examiner
at page 10, item 17, of the answer, there is no claim recitation
regarding the size of transaction folders or the capacity of
local memories. Nor is there any recitation as to how long data
is stored in local memories or as to checking to determine if a
requested document is stored locally before requesting the data
from a central site.

At item 2h. of the brief, appellants argue that just because
Reding teaches the use of a wide area network, and that it is
theoretically possible that one could add Reding's network to
Cukor, is not enough to establish motivation to combine the
teachings of the two references.

This argument is not persuasive. First of all, as indicated
above, Cukor's teaching is of a system of remote stations and

12

central stations, all of which are interconnected. The

interconnecting means is known in the art as a wide area network.

Thus, in this respect, Reding's teaching that digital imaging

technology encompasses wide area networks is merely cumulative to

Cukor. However, even if an unreasonable interpretation were to

be given Cukor and it were to be considered that Cukor's central

stations are isolated, Reding's teaching of wide area network

communications in digital imaging systems would have suggested

the use of such a system in Cukor's digital imaging system so as

to cooperatively link his central stations, thus providing a

larger, more flexible system. Section 103 requires us to presume

that the artisan has full knowledge of the prior art in his field

of endeavor and the ability to select and utilize knowledge from

that art. In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315

(Fed. Cir. 1986).

Lastly, at pages 15-17 appellants argue that the combination

of Cukor, Reding and Wang does not teach, suggest or render

obvious the subject matter of dependent claims 26 and 30.

It is urged that Wang does not teach folders and that,

assuming arguendo that Wang teaches folders, those portions of

Wang relied on by the examiner fail to describe how or why one

adds images to an existing folder or moves an image from one

folder to another. With respect to claim 26, appellants contend

that the passage cited in column 5, lines 49-52, is unclear as to

whether a new document is added to the image code 16 or if more

information is simply amended onto the image code. As to claim

30, appellants assert that the passage cited by the examiner in

column 6, lines 27-31, is unclear as to whether Wang copies a

field within a document to another document and keeps the field

on the same document, or actually takes a whole field, copying it

into a second folder and deleting it from the original folder.

Finally, it is urged that there is no motivation to combine the

features of Wang with Cukor because Cukor manages bills of

lading, and there is no reason to transfer one bill of lading

from one folder into another.

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things, Wang'   ~~system for filing

documents, su~   ~~tients. As such, it

stores files (~~s a folder is

nothing more t~~   ~~e documents, Wang

discloses folders. In this regard, at column 2, lines 6 and 7, Wang discloses that his system relates documents to an identified entity (claim 26). As noted by the examiner at page 11, item 20, of the answer, either interpretation of Wang's teaching at column 5, lines 49-52, reads on claim 26. Furthermore, as stated in the answer at page 12, item 21, whether Wang teaches copying a document to a second folder and deleting the first folder is irrelevant because no such feature is claimed in claim 30.

Lastly, appellants' argument that there is no motivation to combine the teachings of Cukor and Wang is not persuasive because it argues Cukor alone, not the prior art as a whole. As noted above, Wang teaches transfer of medical and other data in a document storage system from a first folder to a second folder. The storage of such data in Cukor, and transfer thereof between folders in the larger, more complex system of Cukor would have been obvious. Motivation to transfer data between folders would have been, for example, to transfer the medical history of a patient from a central transaction processing facility at a medical center in one city to that of the central facility of a medical center in another city where the patient is currently in need of care.
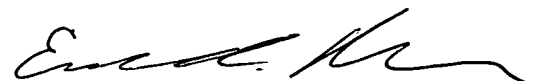
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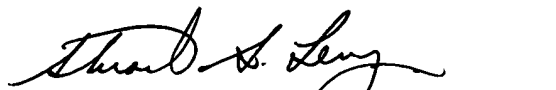Serial No. 08/626,600

Summary

In view of our opinion, above, on the issues raised, we will sustain the outstanding rejections.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

STANLEY M. URYNOWICZ, JR.   )
Administrative Patent Judge   )
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)   BOARD OF PATENT
ERROL A. KRASS   )   APPEALS AND
Administrative Patent Judge   )   INTERFERENCES
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STUART S. LEVY   )
Administrative Patent Judge   )

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